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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,725	08/05/2000	Naren Chaganti	PSCO-007	2559

7590 12/09/2004
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EXAMINER

DARROW, JUSTIN T

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/634,725

Applicant(s)

CHAGANTI ET AL.

Examiner

Justin T. Darrow

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-3 have been presented for examination. Claim 1 has been amended and new claim 2 has been added in an amendment filed 11/06/2002. Claims 1 and 2 have been amended and new claim 3 has been added in an amendment filed 04/10/2003. Claim 2 has been amended in an amendment filed 06/14/2004. Claims 1-3 have been examined.

Priority

2. Acknowledgment is made of the benefit of an earlier filing date of parent Application No. 09/478,796, filed on 01/07/2000.

Response to Amendment

3. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

1. The amendment to the claim 3 filed on 06/14/2004 does not comply with the requirements of 37 CFR 1.121(c) because claim 3 is designated (original), when it newly added in an amendment filed 04/10/2003. Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers

Art Unit: 2132

in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of “canceled” or “not entered” may be aggregated into one statement (*e.g.*, Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as “canceled” will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a “new” claim with a new claim number.

Since this error in the reply filed on 06/14/2004 appears is a minor formality, the reply is being considered fully on the merits in this Office action.

Art Unit: 2132

Drawings

4. The drawings for figures 1-3 filed on 04/10/2003 by facsimile are acceptable subject to as indicated on the "Notice of Draftperson's Patent Drawing Review," PTO-948, Paper No. 16.

5. The drawings for figures 4-7 filed on 12/16/2003 by mail were received on 12/19/2003. These drawings are approved by the draftperson and the examiner.

Response to Arguments

6. Applicant's arguments concerning claim 2 filed 06/14/2004 have been fully considered but they are not persuasive. In the remarks filed 06/14/2004, page 4, lines 8-22, the applicant believes that the last Office action mailed 02/12/2004 stated that the limitation, "step for associating with each information object at least one of a plurality of security clearance levels, thereby enabling access to individually selected portions of the user's personal information by different receiving parties," was novel over Fortenberry et al., U.S. Patent No. 6,005,939 A. The Office action recited no such finding. Because this limitation was not in the claim, the subject matter contained therein was not given patentable weight in the examination of claim 2 and not considered.

7. As per claim 2, Fortenberry et al., U.S. Patent No. 6,005,939 A teaches:

step for associating with each information object at least one of a plurality of security clearance levels, thereby enabling access to individually selected portions of the user's personal information by different receiving parties (see column 7, lines 24-30; figure 3, items 304 and 306; security level is assigned to each item of the user information included in the passport data field; see column 7, lines 53-60; security levels assigned to each item of user information range

Art Unit: 2132

from highly secure to public, for a high security level of 100 on an exemplary scale of 0-100 levels to public level 0; see column 8, lines 40-64; figure 2, item 216; figure 5, process blocks 512, 514, 518, and 520; based on the security level of the identified information, the passport agent determines whether or not the requested information should be transmitted to the vendor in encrypted form, where the vendor may decrypt the encrypted identified information of the passport only if that vendor is sent the particular public key by the user corresponding to the security level of that identified information; see column 8, lines 25-31; figure 5, process block 502; where the user requests a transaction with a particular vendor of a plurality of different vendors who are receiving parties).

Fortenberry et al. clearly do elaborate on the “assignment of security levels at any granularity” when they mention that a security level is assigned to each item of the user information included in the passport data field, where the security levels assigned to each item of user information range from highly secure to public, for a high security level of 100 on an exemplary scale of 0-100 levels to public level 0. In response to applicant's argument that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., “the security levels can be assigned so as to allow individually selected portions of the information objects to be released to different receiving parties”) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

8. Applicant's arguments, see page 4-6 of Remarks, filed 06/14/2004, with respect to the rejections of claims 1 and 3 under 35 U.S.C. § 102(e) have been fully considered and are

Art Unit: 2132

persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection is made in view of PR Newswire, "STAC's New ReachOut 6.0 for Windows 95 Delivers Worldwide Web Browser Access to Your Desktop Files."

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by PR Newswire, "STAC's New ReachOut 6.0 for Windows 95 Delivers Worldwide Web Browser Access to Your Desktop Files."

Art Unit: 2132

As per claim 1, PR Newswire reports a method of creating an online library on a first computer communicatively coupled to a network (see ¶ 2; a user with a desktop containing files with remote access via modem, network, remote node and the Internet), comprising:

allocating storage area on the first computer, configured to hold items (see ¶ 2; remote and mobile users have a need for information that they can store on a computer with them);

accessing a second computer coupled to the network, having an item of interest, other than an executable application (see ¶ 5; remote file transfer from their desktop PCs using File Transfer Protocol (FTP) for accessing file archives around the world that are linked to the Internet);

dragging and dropping the item of interest into the storage area (see ¶ 6; Windows 95 Explorer-like view with drag & drop capabilities to facilitate the transfer of files between multiple remote hosts);

assigning at least one of a plurality of security levels at any granularity to the item of interest (see ¶¶ 5-6; built-in security features to allow users to securely publish their desktop on the Internet such that files and subdirectories are accessible to those they designate);

issuing a secure access authorization key to access the item of interest, comprising conditional access authorization (see ¶ 5; user IDs, assigned passwords, and access restriction for files to be accessible to those that users designate); and

accessing the item of interest based on conditions established by the secure access authorization key (see ¶ 7; when a user gets to any PC that has a web browser installed, the user can securely access his desktop files).

Art Unit: 2132

As per claim 3, PR Newswire discloses a method of creating an online library on a first computer communicatively coupled to network (see ¶ 2; a user with a desktop containing files with remote access via modem, network, remote node and the Internet), comprising:

allocating storage area on the first computer, configured to hold items (see ¶ 2; remote and mobile users have a need for information that they can store on a computer with them);

accessing a second computer to the network, having an item of interest, being other than an executable application (see ¶ 5; remote file transfer from their desktop PCs using File Transfer Protocol (FTP) for accessing file archives around the world that are linked to the Internet);

dragging and dropping the item of interest into the storage area (see ¶ 6; Windows 95 Explorer-like view with drag & drop capabilities to facilitate the transfer of files between multiple remote hosts); and

assigning at least one of a plurality of security levels at any granularity to the item of interest (see ¶¶ 5-6; built-in security features to allow users to securely publish their desktop on the Internet such that files and subdirectories are accessible to those they designate).

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. The reference, "STAC's New ReachOut 6.0 for Windows 95 Delivers Worldwide Web Browser Access to Your Desktop Files," discloses a sale of a product anticipating the invention (see ¶ 1, STAC, Inc. unveiled 06/24/1996 a new version the ReachOut® remote access software product for sale to the public).

Art Unit: 2132

10. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Fortenberry et al., U.S. Patent No. 6,005,939 A.

Fortenberry et al. depict a method for automatically disbursing a first party's personal information, comprising:

step for inputting the first party's personal information comprising at least one of a plurality of information objects, being other than an executable application (see column 6, lines 52-55; figure 3, item 305; real information about a user such as the user's real name, address, credit card information, social security number, etc.; column 6, lines 63-67; column 7, lines 1-9; figure 3, item 305; virtual information includes user's preferences);

step for associating with each information object at least one of a plurality of security clearance levels, thereby enabling access to individually selected portions of the user's personal information by different receiving parties (see column 7, lines 24-30; figure 3, items 304 and 306; security level is assigned to each item of the user information included in the passport data field; see column 7, lines 53-60; security levels assigned to each item of user information range from highly secure to public, for a high security level of 100 on an exemplary scale of 0-100 levels to public level 0; see column 8, lines 40-64; figure 2, item 216; figure 5, process blocks 512, 514, 518, and 520; based on the security level of the identified information, the passport agent determines whether or not the requested information should be transmitted to the vendor in encrypted form, where the vendor may decrypt the encrypted identified information of the passport only if that vendor is sent the particular public key by the user corresponding to the security level of that identified information; see column 8, lines 25-31; figure 5, process block

Art Unit: 2132

502; where the user requests a transaction with a particular vendor of a plurality of different vendors who are receiving parties);

step for recording each information object and the associated security clearance level (see column 6, lines 47-51; figure 3, items 304, 305, 306, 308; passport portion in the passport agent includes fields; see column 6, lines 52-65; figure 3, item 305; first field for user identifying and virtual information; see column 7, lines 24-25; figure 3, item 306; second field corresponding to a security level field; see column 7, lines 31-33; figure 3, item 308; a key field for one or more keys for identifying the data along with the user name) being at any granularity (see column 7, lines 55-58; with particularly sensitive information may be designated as highly secured and assigned a high security level of 100 on an exemplary scale of 0-100 levels);

step for selecting a first portion of the first party's personal information objects that could be transmitted to a receiving party in accordance with criteria established in response to a request from the receiving party (see column 8, lines 46-51; figure 2, item 216; figure 5, process block 512; passport agent determines whether or not the requested information should be transmitted to the vendor in encrypted form; see column 8, lines 1-7; security key at a level corresponding to security level of any real-ID, virtual-ID and less private information);

step for inputting an authorization key to access the first party's personal information (see column 8, lines 37-42; figure 5, process block 508; the vendor requests relevant information with a request for information that includes RELEASE-TYPE, MY-USER-ID, and INTERNET-SITE);

Art Unit: 2132

step for determining a response message to be sent (see column 8, lines 46-55; figure 5, process blocks 512 and 514; after passport agent determines what data must be encrypted, the encryption process is carried out with the private key); and

step for outputting the response message (see column 8, lines 54-64; figure 5, process blocks 514 and 516; passport agent encrypts information and vendor receives encrypted information).

11. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Ho, U.S. Patent No. 6,148,342 A.

Ho illustrates a method for automatically disbursing a first party's personal information, comprising:

step for inputting the first party's personal information comprising at least one of a plurality of information objects, being other than an executable application (see column 2, lines 34-56; figure 1, item 104; user inputs data into a source terminal such as information about a particular individual);

step for associating with each information object at least one of a plurality of security clearance levels, enabling access to individually selected portions of the user's personal information by different receiving parties (see column 4, lines 6-15 and figure 1, items 120 and 157; partitioning sensitive data and distributing storage and retrieval of sensitive data including x-ray, lab results, or patient's records relating to a subject identified by subject I.D., in

Art Unit: 2132

accordance with an access level, such as a doctor out of a plurality of different doctors with individual access levels);

step for recording each information object and the associated security clearance level being at any granularity (see column 3, lines 63-67; figure 1, items 128 and 112; identifier database uses information contained in identifier to generate an access level indicating the access allowances of the user requesting data and an internal identifier identifying the individual or entity (the subject) corresponding to the requested data; see column 4, lines 11-15; where a doctor may have extensive access, corresponding to a high access level; see column 5, lines 2-6; but, where an administrator has limited access, such as to a patient's diagnosis, but not a patient's identity, corresponding to limited access);

step for selecting a first portion of the first party's personal information objects that could be transmitted to a receiving party in accordance with criteria established in response to a request from the receiving party (see column 4, lines 38-58 and figure 1, items 152, 157, and 140; a data request database performing a requested operation on records keyed to a subject internal identifier; see column 4, lines 11-14; such that a doctor with a corresponding access level is permitted to review x-ray, lab results, or add a progress note to the patient's records;

step for inputting an authorization key to access the first party's personal information (see column 4, lines 2-6; figure 1, items 118, 132, and 120; user requesting data inputs a user I.D. used to identify the data for lookup in table and determine the user's approved access level in relation of the individual identified in the subject I.D. section);

step for determining a response message to be sent (see column 4, lines 51-58 and figure 1, items 152, 118, 132, 136, 144, 157, and 140; the data request database determining if the user

Art Unit: 2132

access level is sufficient to perform the type of data access requested in a data access request upon the records corresponding to the subject internal identifier; see column 5, lines 12-21 and figure 1, items 152 and 104; see column 5, lines 12-21 and figure 1, items 152 and 104; that can be sent to a user at the source terminal either over a secured line or encrypted; see column 2, lines 61-67; column 3, lines 1-4; and figure 1, item 118; or based upon the user I.D. with information on the user; see column 6, lines 26-29 and figure 2, block 224; such that the user and subject form a doctor-patient pair; see column 2, lines 61-67; column 3, lines 1-4; and figure 1, item 118; a first subdata packet containing a user I.D. with information on the user; see column 4, lines 2-6 and figure 1, items 118, 132, and 120; data for lookup in an access level table to determine the user's approved access level in relation to the individual identified in the subject I.D. section if the user has an appropriate user access level, the data request database performing an operation upon the records keyed to the subject internal identifier; see column 4, lines 54-58 and figure 1, items 152, 157, 140, and 144; including retrieving laboratory results from a table of data records (see column 5, lines 12-17 and figure 1, items 152 and 157); and

step for outputting a response message (see column 5, lines 12-21 and figure 1, items 152 and 104; sending a result of the data operation to a user at the source terminal either over a secured line or encrypted.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (571) 272-3801, and

Art Unit: 2132

whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed **"OFFICIAL FAX"**. Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an amendment after final rejection have printed not only **"OFFICIAL FAX"** but also **"AMENDMENT AFTER FINAL"**.

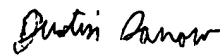
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2132

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100 thereafter.

December 4, 2004



**JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100**